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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/671,341

09/25/2003

Stephen A. Baum

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EXAMINER

GROSS, CHRISTOPHER M

ART UNIT

PAPER NUMBER

1639

MAIL DATE

DELIVERY MODE

10/02/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/671,341	Applicant(s) BAUM, STEPHEN A.	
	Examiner CHRISTOPHER M. GROSS	Art Unit 1639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 23 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 46,47,49-51,54 and 56-85 is/are pending in the application.
- 4a) Of the above claim(s) 57,59,63-85 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 46,47,49-51,54,56,58,60-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Responsive to communications entered 6/23/2008. Claims 46-47,49-51,54,56,57-85 are pending. Claims 57,59,63-85 are withdrawn. Claims 46,47,49-51,54,56,58,60-62 are under consideration.

Priority

Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the prior application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Prods., Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994) [taken from MPEP 201.01]

The instant application, filed 9/25/2003 claims priority as a DIV of application 09/082,038 filed 05/20/1998 (now PAT 6,872,535; referred to as '535). It is noted, however that sufficient support for "solid phase supports in the columns are substantially aligned" as set forth in amended claim 46 is not disclosed in the earlier application (09/082038). See also new matter considerations below.

Response to Arguments

On p 3 through the first full paragraph on p 4 of the remarks entered 6/23/2008, Applicant attempts to point to support for the genus of solid phase supports being substantially aligned in column 3 lines 11-23 and column 16 lines 55-57 as well as figures 13-17 and 29 of '535.

As a convenience to the reader said passages are reproduced below with column 3 shown first:

...**the supports include the inner walls of tubes** or the supports are suspended in tubes, the tubes being secured in two-dimensional (2D) frameworks, wherein the 3D array includes a plurality of such 2D frameworks of tubes stacked with the inner walls of the **tubes substantially aligned**, and wherein the inner walls form side walls for a plurality of wells; or 5) **the supports comprise beads contained in porous enclosures**, the porous enclosures having non-porous side walls and being secured in 2D frameworks, wherein the 3D array comprises a plurality of such 2D frameworks of **porous enclosures stacked with the enclosure side walls substantially aligned**, and wherein the enclosure side walls form side walls for a plurality of wells.

[In regard to figure 21] ...inner walls of **tube supports** 2120 **substantially aligned**, a well 2110 for delivering reagents and synthesizing such molecules is provided.

Emphasis added.

Here, as mentioned in the previous office action on pp 4-5, '535 provides support for substantially aligned tube type solid phase support species, but *not* the entire genus of solid phase supports, as there is no indication that other types of supports (e.g

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spheres) as being substantially aligned. Notably, in the embodiment utilizing solid phase support beads in porous enclosures quoted from '535 above, it is the enclosures *themselves* that are substantially aligned, rather than the small solid phase support beads inside.

In fact, it is noted that the sphere type of solid phase supports shown in figure 14 of '535 (representing a cross-section of figures 12 and 13), do not appear to be substantially aligned. Figures 15,17 and 29 each show more tube solid phase supports. Figure 16 illustrates the embodiment comprising solid phase support beads in aligned porous enclosures, discussed above.

In conclusion, the passages cited by applicant is not commensurate in scope with the presently claimed subject matter thus 9/25/2003 remains the date for the purposes of prior art concerning claims 46,47,49-51,54,56,58,60-62.

Maintained Claim Rejection(s) - 35 USC § 102

Claims 46,47,49-51,54,56,58,60-62 are rejected under 35 U.S.C. 102(b) as being anticipated by **Stein et al.**

Response to Arguments

Applicant argues, see p 4 second full paragraph of remarks entered 6/23/2008, that the claims are entitled to a priority date of 5/20/1998 meaning Stein et al does not represent prior art under 35 USC 102(b).

In view of the denial of priority, detailed above, 9/25/2003 remains the date for the purposes of prior art, thus the examiner submits that Stein et al constitutes prior art under 35 USC 102(b).

Maintained Claim Rejection(s) - 35 USC § 112

Claims 46,47,49-51,54,56,58,60-62 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement concerning new matter.

Response to Arguments

Applicant argues, see p 5 first full paragraph of remarks entered 9/25/2003 that the limitation of 'solid phase supports in the columns are substantially aligned' does not constitute new matter with support being found in the disclosure on p 5 lines 5-14, p 30 lines 22-24 and figures 13-17,21,29 of the present case.

In regard to figure 21, it is once again noted that the substantially aligned solid phase supports shown therein are tubes.

Applicant admits the specification and figures of the present case are the same as that set forth the priority document (US Patent 6,872,535) In this vein, the examiner notes that the above passages and figures 13-17 and 29 appear identical to '535, and therein applicant does not offer further arguments regarding further support for 'solid phase supports in the columns are substantially aligned' beyond what was set forth with regard to priority. To the extent that Applicant is merely repeating their previous argument, the Examiner contends that those issues were adequately addressed in the above priority section, which are incorporated in their entireties herein by reference.

The examiner most respectfully submits therefore, the passages cited by applicant, by only providing support for tube solid phase supports, are not commensurate in scope with the genus of solid phase supports including beads, spheres, etc. being substantially aligned.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Gross whose telephone number is (571)272-4446. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. Douglas Schultz can be reached on 571 272-0763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher M Gross
Examiner
Art Unit 1639

cg

/JD Schultz, PhD/
Supervisory Patent Examiner, Art Unit 1635